



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI DEVICE CO., LTD.,
Petitioner,

v.

OPTIS CELLULAR TECHNOLOGY, LLC,
Patent Owner.

Case IPR2018-00816
Patent 8,437,293 B2

Before KALYAN K. DESHPANDE, MICHAEL R. ZECHER, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner, Huawei Device Co., Ltd. (“Huawei”), filed a Request for Rehearing under 37 C.F.R. § 42.71(d) (Paper 17 (“Req. Reh’g”)), along with Exhibits 1039–1041. Huawei’s Request for Rehearing seeks reconsideration of the Decision Denying Institution of *inter partes* review of claims 1–4, 10–15, and 19–23 of U.S. Patent No. 8,437,293 B2 (Ex. 1001, “the ’293 patent”). Paper 13 (“Dec.”).

In its Request for Rehearing, Huawei contends that our determination not to institute an *inter partes* review is improper for two reasons. First, Huawei argues that we misapprehended or overlooked certain evidence regarding the proper construction of the claim term “scheduling request” (“SR”). Req. Reh’g 2–11. Second, Huawei argues that we misapprehended or overlooked certain portions of the Petition that purportedly explain how the asserted prior art teaches or suggests a scheme where the claimed “second SR” is a single bit message. *Id.* at 11–15.

As we explain below, we have considered the arguments presented by Huawei in its Request for Rehearing, but we discern no reason to modify the Decision Denying Institution. As a result, we *deny* Huawei’s Request for Rehearing.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* When rehearing a decision on a petition, we review the decision

for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). With this in mind, we address the arguments presented by Huawei in turn.

III. ANALYSIS

A. Huawei has not made a “good cause” showing for admitting Exhibits 1039–1041 with the Request for Rehearing

As an initial matter, we address whether Huawei followed the proper procedure for admitting Exhibits 1039–1041 into the record of this proceeding. As we explain above, Huawei filed its Request for Rehearing, along with Exhibits 1039–1041. These exhibits were not of record at the time the Decision Denying Institution was entered on November 5, 2018. Compare Paper 18 (“Petitioner’s Updated Exhibit List”), with Paper 2 (“Pet.”), i–iii (“Petitioner’s Initial Exhibit List”).

The rule governing a rehearing request permits “[a] party dissatisfied with a decision . . . [to] file *a single request for rehearing* without prior authorization from the Board.” 37 C.F.R. § 42.71(d) (emphasis added). This rule does not address explicitly whether the requesting party also may file new evidence with its rehearing request. The *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756 (Aug. 14, 2012) (“*Practice Guide*”), however, is instructive on this matter. When discussing general procedures

applicable to rehearing requests, the *Practice Guide* states that “[e]vidence not already of record at the time of the decision will not be admitted absent a showing of *good cause*.” *Id.* at 48,768 (emphasis added). Ideally, a party seeking to admit new evidence with a rehearing request would request a conference call with the Board prior to filing such a request so that it could argue “good cause” exists for admitting the new evidence. Alternatively, a party may argue “good cause” exists in the rehearing request itself.

Here, Huawei did not request a conference call with the Board prior to submitting Exhibits 1039–1041 with its Request for Rehearing entered on December 5, 2018. Nor did Huawei explain why these exhibits should be admitted in the Request for Rehearing itself. *See generally* Req. Reh’g 1–15. Absent a showing of “good cause” prior to filing the Request for Rehearing or in the Request for Rehearing itself, these exhibits should not be admitted and, therefore, they are not entitled to consideration. Consequently, we exercise our authority under 37 C.F.R. § 42.7(a) to expunge Exhibits 1039–1041.

B. We did not misapprehend or overlook certain evidence regarding the proper construction of the claim term “scheduling request”

Huawei presents three arguments as to why we misapprehended or overlooked certain evidence regarding the proper construction of the claim term “scheduling request.” Req. Reh’g 2–11. We address each argument in turn.

First, Huawei contends that our construction limiting the claim term “scheduling request” to a single bit message is inconsistent with the specification of the ’293 patent and contrary to precedent from the U.S. Court of Appeals for the Federal Circuit. Req. Reh’g 3. According to

Huawei, the disparaging language in the specification identified in the Decision Denying Institution that purportedly limits the claimed “scheduling request” to a single bit message only focuses on the problem arising in prior art solutions. *Id.* at 3–4. Huawei argues that the inventive aspect of the ’293 patent is applicable to any scheme using a SR, including schemes where the SR is extended to include a several bit message, because the disclosed invention does not require any particular number of bits in the SR. *Id.* at 5. Huawei then directs us to embodiments disclosed in the specification that purportedly have SRs that include several bit messages because they place no restriction on the size of the SR. *Id.* at 5. Huawei also attempts to distinguish the cases we cited in the Decision Denying Institution to support a disclaimer because these cases lack consistent language limiting the SR to a single bit message or lack a nexus between the disparaging comments and the description of the claimed invention in the specification. *Id.* at 6–7.

We are not persuaded by Huawei’s argument that that our construction limiting the claim term “scheduling request” to a single bit message is inconsistent with the specification of the ’293 patent. As we explained in the Decision Denying Institution, the ’293 patent explicitly states that “[e]mbodiments of the present invention overcome the . . . problem [arising in the prior art solutions] . . . without increasing the SR from one bit to several bits.” Dec. 11–13 (quoting Ex. 1001, 6:7–14). This statement is not limited to just the problem arising in the prior art solutions, but rather directly speaks to one of the objectives of the ’293 patent. We fail to see how the inventive aspect of the ’293 patent is applicable to any scheme using a SR, including schemes where the SR is extended to include a several bit message, when this patent explicitly states that embodiments of

the present invention solve the problem arising in prior art solutions “without increasing the SR from one bit to several bits.” Ex. 1001, 6:13–14. Huawei’s reliance on embodiments disclosed in the specification that purportedly have SRs that include several bit messages because they place no restriction on the size of the SR is misplaced. Simply because these embodiments do not preclude extending an SR to include a several bit message does not mean that they support reading the specification in this way. Notably absent from the descriptions of these embodiments is an explicit statement that the SR may be extended to include a several bit message. As we explained in the Decision Denying Institution, there are several disclosures in the specification of the ’293 patent that disclaim reading any embodiments disclosed therein as having an SR that includes a several bit message. See Dec. 11–12 (citing Ex. 1001, 6:3–9, 6:13–14, 10:26–32).

We also are not persuaded by Huawei’s argument that our construction limiting the claim term “scheduling request” to a single bit message is contrary to Federal Circuit precedent. In the Decision Denying Institution, we stated that, “[w]hen applying the broadest reasonable interpretation standard, the . . . Federal Circuit has cautioned against construing a claim term ‘so broad as to include a configuration expressly disclaimed in the specification.’” Dec. 10–11 (quoting *In re Man Mach. Interface Techs. LLC*, 822 F.3d 1282, 1286 (Fed. Cir. 2016) (citing *SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1316–17 (Fed. Cir. 2015)). Huawei’s attempt to distinguish these two cases from the circumstances presented here is belied by our analysis in the Decision Denying Institution. As we explained in the Decision Denying Institution,

the specification of the '293 patent consistently limits an SR to a single bit message, and it includes a sufficient nexus between the disclosures that disparage extending an SR to a several bit message and a stated objective of the claimed invention. *See* Dec. 11–13.

Second, Huawei contends that the plain and ordinary meaning of the claim term “scheduling request” leaves open the possibility that such a request may encompass a several bit message. *Req. Reh’g* 7. According to Huawei, when an SR is first described in the specification of the '293 patent, it does not limit the number of bits in the SR. *Id.* Huawei further argues that each disclosure in the specification that mentions the number of bits in an SR is limited to particular embodiments. *Id.* at 7–8.

We are not persuaded that the plain and ordinary meaning of the claimed term “scheduling request” in light of the '293 patent should encompass a several bit message. The Federal Circuit has explained that the correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is “an interpretation that corresponds with what and how the inventor describes his invention in the specification, i.e., an interpretation that is ‘consistent with the specification.’” *In re Smith Int’l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017). As we explained in the Decision Denying Institution, the broadest reasonable interpretation of the claim term “scheduling request” in light of the specification of the '293 patent “should be limited to a single bit message because the specification disclaims extending the scope of this claim term to encompass a several bit message.” Dec. 13.

Huawei’s argument that the first description of an SR in the specification does not include a limit on the number of bits in the SR focuses

on a description of a “basic uplink scheduling concept” in the “Background” section of the ’293 patent. *See* Ex. 1001, 2:4–50, Fig. 2. In our view, this description of a “basic uplink scheduling concept” refers to what is known generally in the prior art and fails to take into account a stated objective of the ’293 patent, which is to solve the problem arising in prior art solutions “without increasing the SR from one bit to several bits.” *Id.* at 6:13–14. We acknowledge that, when describing how the SR is limited to a single bit message, the specification occasionally uses language such as “[i]n some embodiments” and “[o]ne possible scheduling request scheme.” Ex. 1001, 3:39–40, 5:14–17. We accounted for this language in our claim construction analysis of the claim term “scheduling request.” *See* Dec. 11–12.

Nevertheless, we determined that this language did not overcome the “other disclosures in the specification that disclaim broadly defining an SR as a several bit message.” *Id.* at 11. Our determination in this regard is further bolstered by the fact that Huawei does not direct us to, nor could we find, a single embodiment in the specification that explicitly states the SR may be extended to include a several bit message.

Third, Huawei contends that Patent Owner, Optis Cellular Technology, LLC (“Optis”), took an inconsistent position regarding the proper construction of the claim term “scheduling request” because in the related district court case it sought to construe this claim term based on its plain and ordinary meaning, whereas in this proceeding it sought to limit this claim term to a single bit message. *Req. Reh’g* 8–11. We could not have misapprehended or overlooked this argument because this is a new argument presented for the first time in the Request for Rehearing. In its Petition, Huawei did not propose a construction for the claim term “scheduling

request.” *See generally* Pet. 13–17. In its Preliminary Response, Optis proposed a construction for the claim term “scheduling request” because it contended that Huawei presented arguments in the Petition that stretched the scope and meaning of this claim term beyond its plain and ordinary meaning to one of ordinary skill in the art in the context of the entire disclosure of the ’293 patent. Paper 6, 22–27. After receiving notice that the scope and meaning of the claim term “scheduling request” was in dispute, Huawei could have reached out to us to request authorization to file additional briefing on this issue. Huawei, however, did not seek authorization to file additional briefing. Because Huawei did not attempt to bring this issue to our attention prior to entering the Decision Denying Institution, we decline to consider this argument for the first time on rehearing.

C. We did not misapprehend or overlook certain portions of the Petition that purportedly explain how the asserted prior art teaches or suggests a scheme where the claimed “second SR” is a single bit message

Huawei contends that, even under our construction limiting the claim term “scheduling request” to a single bit message, it presented and developed arguments in the Petition that would permit us to grant institution of trial. Req. Reh’g 11–12. According to Huawei, in the portion of the Petition addressing the motivation to combine the teachings of Lohr and TS 25.309, it specifically discussed how Lohr teaches or suggests a scheme where the claimed “second SR” is a single bit message. *Id.* at 12–15. In the context of making this argument, Huawei included a footnote that states “[Huawei] recognizes that it did not specifically apply this argument to the claimed ‘second SR.’” *Id.* at 12 n.5. We could not have misapprehended or overlooked this argument because, as Huawei admits, it did not apply this

argument to the claimed “second SR.” In essence, Huawei requests that we search through all sixty-seven pages of the Petition to unearth support for its newly minted theory that Lohr teaches or suggests a scheme where the claimed “second SR” is a single bit message. If Huawei desired for us to consider one portion of the Petition as supporting arguments presented and developed in another portion of the Petition, it should have provided citations to those portions with particularity.

IV. CONCLUSION

For the foregoing reasons, Huawei has not demonstrated that we abused our discretion in not instituting an *inter partes* review of claims 1–4, 10–15, and 19–23 of the ’293 patent. In particular, Huawei has not persuaded us that we misapprehended or overlooked (1) certain evidence regarding the proper construction of the claim term “scheduling request”; or (2) certain portions of the Petition that purportedly explain how the asserted prior art teaches or suggests a scheme where the claimed “second SR” is a single bit message.

V. ORDER

Accordingly, it is

ORDERED that, pursuant to 37 C.F.R. § 42.7(a), Exhibits 1039–1041 are expunged from the record of this proceeding because Huawei did not follow the proper procedure for admitting new evidence with its Request for Rehearing; and

FURTHER ORDERED that Huawei’s Request for Rehearing is *denied*.

IPR2018-00816
Patent 8,437,293 B2

For PETITIONER:

Peter P. Chen
David A. Garr
Anupam Sharma
COVINGTON & BURLING LLP
pchen@cov.com
dgarr@cov.com
asharma@cov.com

For PATENT OWNER:

Brent N. Bumgardner
Matthew C. Juren
NELSON BUMGARDNER ALBRITTON P.C.
bbumgardner@nbclaw.net
matthew@nelbum.com